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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/518,375   | 09/09/2005  | Toshirou Ariga         | 80356(47762)        | 2853             |
| 21874 7590 05/14/2008<br>EDWARDS ANGELL PALMER & DODGE LLP<br>P.O. BOX 55874<br>BOSTON, MA 02205 |             |                        |                     |                  |
| EXAMINER<br>JOY, DAVID J   |             |                        |                     |                  |
| ART UNIT<br>1794   |             | PAPER NUMBER           |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/518,375

**Applicant(s)**

ARIGA ET AL.

**Examiner**

David J. Joy

**Art Unit**

1794

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-5 and 7-11 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date 12/28/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application.
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.
2. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.
3. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.
  - a. Group I, Claims 1-5 and 7-10, drawn to a transfer film.
  - b. Group II, Claim 11, drawn to a method of producing a transfer body.
4. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the inventions of Groups I and II lack the same technical features, as the invention of Group I is drawn to a transfer *film*, while the invention of Group II is drawn to the production of a transfer

*body*, which includes such technical features as the body onto which the film is to be transferred. As a result, a lack of unity of invention exists.

5. During a telephone conversation with James E. Armstrong, IV on March 28, 2008 a provisional election was made without traverse to prosecute the invention of Group I, Claims 1-5 and 7-10. Affirmation of this election must be made by applicant in replying to this Office action. Claim 11 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

7. In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus,

to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Priority***

9. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Specification***

10. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

11. The abstract of the disclosure is objected to. Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. The language should be clear and concise and should not repeat

information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc. Correction is required. See MPEP § 608.01(b).

### ***Claim Objections***

12. Claim 4 is objected to because of the following informalities: The third line of the claim includes a reference number (which is properly set-off in parentheses) that is an alphanumeric character, while the fourth line of the claim contains a reference number that is given as a roman numeral. By comparison, Claim 3 contains two reference numbers, and both of those are provided as roman numerals. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 1-5 and 7-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The requisite contents of the transfer layer

that are recited in lines 8-11 of the claim are unclear. The limitations as they appear in the claim do not definitely delineate whether the transfer layer contains all three of the resins that are recited (i.e., A, B, and C), or whether there is a choice between the first two and then the third is also present (i.e., A or B, and C), or whether only one of the three resins may be present in the transfer layer (i.e., only C).

15. Claims 2-5 and 7-10 are rejected accordingly, as they all depend upon Claim 1.

#### ***Double Patenting***

16. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van*



*Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

17. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

18. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

19. Claims 1-5 and 7-10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1 and 3-6 of copending Application No. 10/574,040 (which was published as U.S. Patent Application Publication No. 2007/0042163). Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application claims a hydraulic transfer film, containing a substrate film, a transfer layer having a curable

resin layer, a decorative layer having an ink or coating film, and a peelable release film on top of the transfer layer at an interface with the transfer layer. The copending application also claims the same components for the various layers of the transfer film.

20. While there is no explicit teaching in the claims of the copending application that the transfer layer contains a curable resin layer which contains a curable resin selected from a radiation-curable resin having at least three (meth)acryloyl groups and a thermosetting resin containing blocked isocyanate and polyol, the specific components of the curable resin layer are taught in the specification to be radical polymerizable oligomers having 2 to 8 acryloyl groups, such as the species polyurethane (meth)acrylate, polyester (meth)acrylate, and epoxy (meth)acrylate, among other possible species for the curable resin layer (see 2007/0042163 at ¶¶ [0043]-[0056] and [0071]-[0077]). In addition, the specification of the copending application also recites that a resin layer can also contain blocked isocyanate and polyol, and in teaching the same polyol species that are taught in the instant application, it follows that the polyol will also have a weight-average molecular weight of 3,000 to 100,000 (see 2007/0042163 at ¶¶ [0050]-[0060]). Also, the specification provides that the non-polymerizable thermoplastic resin that is present in the transfer layer is a resin having a glass transition temperature of within the range of 50 to 150°C and a weight-average

molecular weight of 70,000 to 250,000, and that the thermoplastic resin will be a resin that is compatible with the curable resin, such as a polymethacrylate resin (see 2007/0042163 at ¶¶ [0023]-[0026] and [0038]-[0040]). Finally, the specification of the copending application also provides that the substrate can be made of such materials as polyvinyl alcohol and that the heat lamination temperature of the transfer film is within a temperature range from 40° to 120°C (see 2007/0042163 at ¶¶ [0019]-[0021], [0112] and [0166]). The copending application provides that the motivation for using a transfer film having these components is to produce a hydraulic transfer film that can be hydraulically transferred in one step without transferring defects or deforming the pattern (see 2007/0042163 at ¶ [0018]).

21. Applicant's attention is drawn to MPEP 804 where it is disclosed that "the specification can always be used as a dictionary to learn the meaning of a term in a patent claim." *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent (emphasis added). *In re Vogel*, 422 F.2d 438, 164 USPQ 619, 622 (CCPA 1970). Consistent with the above underlined portion of the MPEP citation, attention is drawn to cited

paragraphs of the copending application that are provided above, where the copending application teaches the specifics of a hydraulic transfer film that is preferably used to apply an intricately patterned decorative layer onto a complex, molded body, just as the claims of the instant application provide.

22. In light of the above, it would therefore have been obvious to one of skill in the art at the time of invention to make a transfer film having a multilayer structure and to incorporate the various components and species into the constituent layers of the transfer film claimed in the copending application cited above, and thereby arrive at the instantly claimed invention.

23. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Conclusion*

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US 6,309,734  
US 4,337,289

10/2001  
06/1982

Taniguchi et al.  
Reed et al.

25. The International Search Report provides a citation to the Japanese patent application publication of Nissha Printing Co, JP 9-164800A, stating that it is a stand-alone reference of particular relevance to Claim 1 of the instant application. However, the reference was not relied upon because it fails to teach the specific requisite components of the transfer layer that are recited in the preliminarily-amended first claim of the instant application.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Joy whose telephone number is (571)272-9056. The examiner can normally be reached on Monday - Friday, 7:00 AM - 3:30 PM EST.

27. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie E. Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. J. J./  
Examiner, Art Unit 1794  
05/07/2008

/Callie E. Shosho/  
Supervisory Patent Examiner, Art Unit 1794